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November 23, 2004

Box: Non-Fee Responses (AF)
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Re: U.S. Trademark Application Serial No. 76/506,584
Filed: April 16, 2003
Mark: **COLOR COMPLETE**
Our Docket No. 7130-126XX/10303992

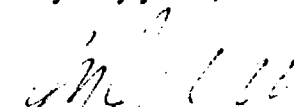
Dear Madam:

Attached hereto for filing are the following documents:

1. Response with Exhibit A in response to the August 25, 2004 Final Office Action;
2. Postcard.

The Commissioner is hereby authorized to charge any deficiency which should have been filed herewith (or with any paper hereafter filed in this application by this firm), under Order No. 7130-126XX/10303992. A duplicate copy of this transmittal is enclosed.

Very truly yours,


M. John Carson

MJC/ags
Enclosures

11-26-2004

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Wella Aktiengesellschaft

Serial No.: 76/ 506,584

Filed: April 16, 2003

For: **COLOR COMPLETE**

Docket No.: 7130-126XX/10303992

=====)

) Examiner: Amos T. Matthews

) Law Office: 108

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Fulbright & Jaworski LLP
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Los Angeles, CA 90017

RESPONSE

Mail Stop: Non-Fee Responses (AF)
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Dear Sir:

I. INTRODUCTION

This is in response to the August 25, 2004 Office Action in which registration was refused under Section 2(e).

II. RELEVANT FACTS

Applicant is applying for registration of the mark COLOR COMPLETE for shampoos, conditioners, hair colors and dyes, hair bleaches, and various other hair care preparations.

Registration has been finally refused on the basis that the words comprising the mark are merely descriptive when applied to the goods.

Applicant submits that the mark COLOR COMPLETE is not merely descriptive. At most, Applicant's mark is suggestive of Applicant's goods. Moreover, in contrast to descriptive terms, Applicant's mark does not immediately convey an idea about the goods, and Applicant's mark has more than one meaning in connection with the goods. All of this indicates that Applicant's mark COLOR COMPLETE is not merely descriptive under the Lanham Act.

III. APPLICANT'S ARGUMENT

A. Summary of Applicant's Argument

For three independent reasons, Applicant submits that the mark COLOR COMPLETE is not merely descriptive. First, Applicant's mark requires imagination and mental pause to convey any idea about the goods and is therefore not merely descriptive. Second, unlike a descriptive term, Applicant's mark has more than one meaning in relation to the goods. Third, at most, Applicant's mark merely suggests a desired result of using the goods and is therefore not descriptive. For these reasons, Applicant contends that its mark COLOR COMPLETE is at most suggestive and thus registrable on the Principal Register.

B. Applicant's Mark Does Not Immediately Describe the Goods and Is Therefore Not Descriptive

It is well settled that a mark is merely descriptive only if it, without more, immediately describes a feature or characteristic of the goods. *In re Abcor Development Corp.*, 588 F. 2d 811, 200 USPQ 215 (CCPA 1978). A mark that requires thought or imagination to convey an idea of the goods is therefore not descriptive. *Id.*

An instructive case is *In re Tennis in the Round Inc.*, 199 USPQ 496 (TTAB 1978). The examiner refused registration of the mark TENNIS IN THE ROUND, for providing tennis facilities in the form of courts and tennis ball machines and offering tennis instruction, under Section 2(e) since the applicant's tennis facility included eleven tennis courts arranged in a circular configuration. The Board decided that the readily recognized meaning of the mark was "a tennis court in the middle of an auditorium with an audience seated on all sides of the

court", by analogy to the well known phrase "theater in the round", whereas in reality, it was the applicant's eleven tennis courts that were arranged together in a circular shape. Because imagination and mental pause were necessary for the mark to convey an idea of the services, the mark did not immediately describe a feature of the services. Therefore, the Board reversed the examiner.

Similarly, in *In re Shutts*, 217 USPQ 363 (TTAB. 1983), the Board decided that the mark SNO-RAKE for a toothless snow removal tool was not descriptive since the literal meaning of the mark was a rake for snow, whereas the actual tool, in the absence of prongs or teeth, was not in fact a rake. Because imagination and mental pause were necessary for the mark to convey an idea of the goods, the mark was not merely descriptive under Section 2(e).

In the present case, Applicant's mark COLOR COMPLETE does not immediately convey a feature or characteristic of the goods. In particular, when applied to shampoos, conditioners and other hair care products, the term "color complete" can be understood as referring to a person's hair, not the goods, conveying the idea that the hair needs nothing more. Because the term "color complete" suggests a person's hair, a consumer seeing COLOR COMPLETE on hair care products would pause to consider whether the mark was a reference to hair or to the products. Therefore, to convey any idea about the goods themselves, thought and imagination would be required to distinguish the goods from the hair. Accordingly, Applicant's mark COLOR COMPLETE is not descriptive.

The Office Action points to an excerpt from Applicant's web site as evidence that Applicant's mark COLOR COMPLETE is descriptive (page 2, lines 3 – 19 of the Office Action). However, the term "color complete" is not used in the excerpt to describe Applicant's hair care preparations. Rather, COLOR COMPLETE is used only as a trademark (page 2, line 16). Thus, nothing in the excerpt supports a finding of descriptiveness.

Further, the excerpt discusses both hair care products and the results of using the products on the hair. As a consequence, any meaning ascribed to Applicant's mark COLOR COMPLETE would apply equally to hair as well as the goods. The excerpt actually supports Applicant's position that a person who sees COLOR COMPLETE on hair care products would require

thought and imagination to determine whether the mark was a reference to hair or to the products. Thus, in contrast to the Office Action's assertion, Applicant's mark is not descriptive.

Moreover, Applicant's mark COLOR COMPLETE can be understood in at least two different ways in reference to hair. As shown in the definition of "complete" from the Merriam-Webster Online Dictionary (attached hereto as Exhibit A), the word "complete" can mean "having all necessary parts" (Definition 1) or "fully carried out" (Definition 4). Accordingly, the term "color complete" can mean that a person's hair has total color (has all necessary parts), or that as far as color is concerned, a person's hair needs nothing more (fully carried out). Because Applicant's mark is ambiguous, a person seeing COLOR COMPLETE on Applicant's goods would pause to consider which meaning was intended. This adds to the amount of thought and imagination necessary to understand Applicant's mark, further demonstrating its non-descriptive nature..

In sum, Applicant's mark COLOR COMPLETE does not immediately convey an idea of Applicant's goods. Further, nothing in the excerpt from Applicant's web site supports a finding of descriptiveness. For these reasons, Applicant's mark is not descriptive.

C. Applicant's Mark Suggests Something Other than the Goods and Is Therefore Not Descriptive

It is also well settled that a mark having more than one meaning in relation to the goods is not descriptive within the meaning of Section 2(e). TMEP 1213.05(c). The case of *In re Colonial Stores Incorporated*, 55 CCPA 1049, 394 F. 2d 549, 157 USPQ 382 (CCPA 1968), is illustrative. Applicant applied for registration of the mark SUGAR & SPICE for bakery goods. The examiner's decision, upheld by the Board, was that the mark is descriptive of bakery goods containing sugar and spice. In overturning the Board's decision, the Court held that the mark is not merely descriptive under Section 2(e) because the mark also suggests something else, a well known nursery rhyme.

Similarly, in *In re Delaware Punch Company*, 186 USPQ 63 (TTAB 1975), the Board held that THE SOFT PUNCH for non-carbonated soft drinks was not merely descriptive of the applicant's non-alcoholic punch in part because the mark also suggests something else, that the drink has an impact like a soft punch or a pleasing hit.

In the present case, Applicant's mark COLOR COMPLETE has a meaning unrelated to the goods. As pointed out in Section B above, when applied to Applicant's goods, COLOR COMPLETE can be understood as referring to a consumer's hair, not Applicant's hair care products. Thus, Applicant's mark suggests something other than the goods.

Moreover, in accordance with the dictionary definitions of "complete", Applicant's mark has at least two meanings in relation to hair- that the hair has total color, or that the hair needs nothing more. Thus, Applicant's mark has more than one meaning.

Unlike a descriptive term, Applicant's mark COLOR COMPLETE suggests something other than the goods, and has more than one meaning. All of this indicates that Applicant's mark is not descriptive.

D. At Most, the Mark "Color Complete" Suggests a Possible or Desired Result of Using the Goods and Is Therefore Not Descriptive

It is well established that a mark is not descriptive if it suggests a possible or desired result of using the goods. *The Fleetwood Company v. The Mitchum Company*, 139 USPQ 281 (CCPA 1963). The case of *The Fleetwood Company* is illustrative. A party opposed registration of the mark FAYD for skin creams. The Trademark Trial and Appeal Board decided in favor of the opposer, finding that the term "FAYD" was the phonetic equivalent of the word "fade", and that "fade" was descriptive of the fading action of a bleaching skin cream. In overturning the Board, the Court found that "fade" did not describe the goods. Rather, "fade" suggested a desired result of using the skin cream. Thus, the mark was entitled to registration.

Similarly, in *In re The Realistic Company*, 169 USPQ 610 (CCPA 1971), the Court found that the mark CURV' for permanent wave curling solutions was entitled to registration. The Trademark Trial and Appeal Board had denied registration, finding that the mark merely described the goods' function of imparting curves to the hair. In reversing, the Court held that CURV' merely suggested a possible result of using permanent wave curling solutions.

The Trademark Trial and Appeal Board follows a similar rule. For example, in *In re C.J. Webb, Inc.*, 182 USPQ 63 (TTAB 1974), the examiner denied registration of a mark after the applicant refused to disclaim the term BRAKLEEN. The goods were a cleaning and degreasing

composition for automotive brake parts. The examiner contended that BRAKLEEN was the phonetic equivalent of "brake clean", and that "brake clean" described the purpose of the goods or the result of their use – to clean brakes or to obtain clean brakes. In overturning the examiner, the Board decided that the term BRAKLEEN was a concise way of saying the phrase "this product will get your brake clean." Because the mark was just the term BRAKLEEN, the mark only suggested a desired result of using the brake cleaner and was therefore not merely descriptive.

Similarly, in *In re Frank J. Curran Co.*, 189 USPQ 560 (TTAB 1975), the examiner denied registration of the mark CLOTHES FRESH for a clothes and shoe spray deodorant. The examiner contended that the mark described the purpose and function of the goods – to freshen clothes. The Board decided that the mark merely suggested a possible and desirable end result of using the spray deodorant. Accordingly, the mark was not merely descriptive. Also, in *In re Aid Laboratories, Incorporated*, 221 USPQ 1215 (TTAB 1983), the Board found that the mark PEST PRUF for animal shampoo with insecticide and deodorizing properties was entitled to registration. Although the examiner contended that the mark was descriptive of a characteristic or intended use of the goods, the Board decided that the mark merely suggested a possible end result of using the goods. Thus, the mark was not descriptive. Further, in *In re Universal Water Systems, Inc.*, 209 USPQ 165 (TTAB 1980), the Board held that the mark PURITY for water filtering units and water cartridges was entitled to registration. The Board disagreed with the examiner's position that the mark merely described a feature, use, function or characteristic of the goods. Rather, the mark suggested a desired result of using the goods and was therefore not merely descriptive.

In the present case, the Office Action contends that Applicant's mark COLOR COMPLETE is descriptive of Applicant's goods. According to the Office Action, Applicant's mark tells consumers that Applicant's goods "will entirely produce vibrant color to the hair" (page 2, lines 19-20). Even assuming for the purposes of argument that Applicant's mark can be understood in this way, Applicant's mark is not descriptive. As in the cases cited above, the goal of entirely producing vibrant color to the hair is simply a possible or desired result of using Applicant's hair care preparations, not a description of any characteristic of the goods.

Moreover, Applicant's mark only suggests a possible or desired result of using the goods. The wording in Applicant's mark does not directly indicate that Applicant's goods will entirely produce vibrant color to the hair. Rather, Applicant's mark consists of only two words, "color" and "complete", that together must convey this idea. Because COLOR COMPLETE does not explicitly tell consumers that the goods will entirely produce vibrant color to the hair, Applicant's mark merely suggests or hints at such a result.

Further, Applicant's mark COLOR COMPLETE is unusual in that the typical order of words in the common term "complete color" is reversed. As such, Applicant's mark refers even less explicitly to the desired result of producing vibrant color to the hair. This adds to the suggestiveness of Applicant's mark.

In sum, Applicant's mark is not descriptive. Even assuming that the mark tells consumers that Applicant's goods will entirely produce vibrant color to the hair, Applicant's mark is merely suggestive of a possible or desired result of using Applicant's hair care products.

E. Doubts as to Descriptiveness Are Resolved in Favor of the Applicant

There is a very thin line of demarcation between a term that is merely descriptive and therefore unregistrable, and a term that is suggestive and thus entitled to registration. *In re TMS Corporation of America*, 200 USPQ 57 (TTAB 1978). Where there is doubt in the matter, the doubt should be resolved in favor of the applicant. *In re Pennwalt Corp.*, 173 USPQ 317 (TTAB 1972); *In re Conductive Systems, Inc.*, 220 USPQ 84 (TTAB 1983); *In re Bel Paese Sales Co.*, 1 USPQ 2d 1233 (TTAB 1986). Therefore, to the extent that there are any doubts as to the merely descriptive nature of Applicant's mark COLOR COMPLETE, such doubts should be resolved in Applicant's favor.

IV. CONCLUSION

Applicant submits that its mark COLOR COMPLETE is not descriptive, for three independent reasons. First, Applicant's mark does not immediately describe Applicant's hair care preparations. Instead, mental thought and imagination are required for the mark to convey any idea about the goods. Second, Applicant's mark has more than one meaning when applied to Applicant's hair care preparations. Third, at most, Applicant's mark is merely suggestive of a

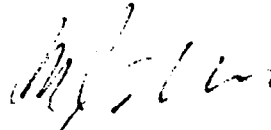
Serial No. 76,506,584
Response to 8/25/04 Office Action

possible or desired result of using Applicant's goods. Each of these reasons is more than sufficient to demonstrate that Applicant's mark COLOR COMPLETE is not merely descriptive under the Lanham Act but rather is suggestive at most and therefore is registrable on the Principal Register.

In view of the foregoing remarks, Applicant submits that the present application is in condition for allowance. Reconsideration is therefore respectfully requested.

Please show our above-referenced docket number with any credit or charge to its Deposit Account No. 50-0337.

Respectfully submitted,



M. John Carson, Esq.
Attorney for Applicant

Date: November 23, 2004

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3 entries found for **complete**.
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complete[1,adjective]
complete[2,transitive verb]
complete fertilizer

Main Entry: **complete**

Pronunciation: käm- 'plät

Function: *adjective*

Inflected Form(s): **com·plet·er**; **-est**

Etymology: Middle English *complet*, from Middle French, from Latin *completus*, from past participle of *complere*

1 a : having all necessary parts, elements, or steps
<complete diet> **b** : having all four sets of floral organs *c of a subject or predicate* : including modifiers, complements, or objects

2 : brought to an end : CONCLUDED <a complete period of time>

3 : highly proficient <a complete artist>

4 a : fully carried out : THOROUGH <a complete renovation> **b** : TOTAL, ABSOLUTE <complete silence>

5 of insect metamorphosis : characterized by the occurrence of a pupal stage between the motile immature stages and the adult -- compare INCOMPLETE **1b**

6 of a metric space : having the property that every Cauchy sequence of elements converges to a limit in the space
synonym see FULL

- **complete·ly** *adverb*

- **com·plete·ness** *noun*

- **com·ple·tive** /- 'plä-tiv/ *adjective*

- **complete with** : made complete by the inclusion of <a birthday cake *complete with* candles>

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